

REMARKS

Claims 1-15 are pending in the Application.

Claims 1-15 stand rejected.

I. REJECTIONS UNDER 35 U.S.C. § 101

Claims 11-15 stand rejected under 35 U.S. C. § 101. The Examiner asserts that these claims are directed to non-statutory subject matter and that § 101 requires a claimed invention to be tangible, but that the claim software is intangible apparently because it recites as being "adaptable" for storage on a storage medium. In response, Applicants respectfully traverse this rejection. The language used by Applicants has been commonly used for many years now, and has been allowed to issue in many patents such as: 6,587,860; 6,570,593; 6,502,137; and 6,501,749.

There is nothing within 35 U.S.C. § 101, or M.P.E.P. § 706.03(a), that states that the use of the term "adaptable" within a computer program product claim makes that claim non-statutory. If the Examiner is going to rely upon § 101 for the rejection, then the Examiner needs to cite either definitive statutory law, case law, or the M.P.E.P. instead of making an unsupported assertion.

II. REJECTIONS UNDER 35 U.S.C. § 112

Claim 10 stands rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Though Applicants respectfully traverse this rejection, claim 10 has been cancelled, primarily because of the threat by the Examiner to restrict this claim nevertheless. This claim is cancelled without prejudice for filing in a subsequent action or continuation application.

III. REJECTIONS UNDER 35 U.S.C. § 103

Claims 1-9 and 11-15 stand rejected under 35 U.S.C. § 103 as being unpatentable over Japanese Patent No. 05-1666066 (the '066 Patent) in view of *Walker et al.* (U.S. Patent No. 6,567,787). In response, Applicants respectfully

traverse this rejection. As the Examiner is well aware, each and every element in the rejected claims must be taught or suggested by the prior art references combined by the Examiner. In claim 1, the step of "automatically performing the override procedure if the second input matches an authorized input in the list of authorized inputs" is not taught or suggested by the prior art references either singly or in combination, contrary to the Examiner's assertion. *Walker* merely teaches that an operation will not be performed unless a person speaks the proper prompt into a microphone coupled to a POS terminal. There is absolutely no teaching or suggestion within *Walker* of an override procedure that is performed as a result of the entering of a properly spoken prompt into the POS terminal. The '066 Patent merely teaches that a plurality of requests requiring a manager override input are collected until a total of the intertransactions is calculated so that the manager input is only required one time, as opposed to each time an item is entered into the system. What the '066 Patent does not teach or suggest is a determination if a manager override input matches authorized inputs. Furthermore, the '066 Patent does not teach or suggest that the override procedure is performed automatically. Instead, the '066 Patent teaches a manual override by the manager.

The present invention notifies an operator of a POS terminal that an override procedure is required, and then once an authorized biometrics override input is received, the override procedure is automatically performed. These steps are not taught or suggested by either of the prior art references, either singly or in combination, and the Examiner is relying solely upon hindsight reasoning in combining the two references. The Examiner's reasoning for combining the references is that it would have been obvious to one of ordinary skill in the art to modify the method of the '066 Patent by receiving a biometrics input and comparing it with authorized inputs as taught by *Walker* in order to determine an authorization level of the person attempting to perform the override and to determine the user's identity via a characteristic that is inherent to that person. The problem with such an assertion is that it is the Examiner's sole subjective opinion, and is not supported by any objective evidence. It is easy for the Examiner to find a couple of references that

teach various limitations within claim 1 and then to make a statement that it would have been obvious to combine the two because it would be advantageous to do so. However, combining prior art references without actual evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability, which is the essence of hindsight. *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). Broad conclusory statements regarding the teaching of multiple references is not evidence, and therefore the Examiner's subjective opinion on how to combine the references is insufficient to support his *prima facie* case of obviousness. *Id.*

Claims 5 and 15 recite that the biometrics device is remotely coupled to the POS terminal through a computer network coupled to the POS terminal. The Examiner attempts to assert that this does not further limit the method or software recited within these claims and therefore the Examiner does not need to address these claims. Applicants respectfully traverse such an assertion by the Examiner. The Examiner has failed to prove a *prima facie* case of obviousness in rejecting claims 5 and 15, since the Examiner has failed to find where in the cited prior art the limitations of claims 5 and 15 are taught or suggested. The Examiner cannot merely ignore claim limitations. Furthermore, Applicants traverse the Examiner's assertion that it is notoriously old and well-known in the art to locate an input device remotely. Thus, the Examiner is required to support such an assertion with objective evidence.

Claims 6 and 11 are patentable for the same reason as given above with respect to claim 1.

IV. CONCLUSION

As a result of the foregoing, it is asserted by Applicants that the remaining Claims in the Application are in condition for allowance, and respectfully request an early allowance of such Claims.

Applicants respectfully request that the Examiner call Applicants' attorney at the below listed number if the Examiner believes that such a discussion would be helpful in resolving any remaining problems.

Respectfully submitted,
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